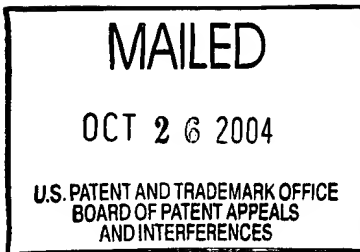


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte RICHARD J. FOLIO

Application No. 09/896,894

ORDER RETURNING UNDOCKETED APPEAL

This application was received at the Board of Patent Appeals and Interferences on September 27, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

On page 3 of the Examiner's Answer mailed August 12, 2003 (Paper No. 16), the examiner listed the following references under the heading "(9) Prior Art of Record";

5,055,939	Karamon et al.	10-1991
5,822,440	Oltman et al.	10-1998

It is noted that the Denenberg reference cited on page 15 of the Examiner's Answer under the heading "Grounds of Rejection" is not included as "Prior Art of Record." In accordance with § 1211 of the Manual of Patent Examining Procedure (MPEP) (7th Ed., Rev. 1, Feb. 2000), clarification is required regarding the pertinence of the Denenberg reference. In addition, MPEP § 1208(A)(9) states:

(A) REQUIREMENTS FOR EXAMINER'S ANSWER.
The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

(9) References of Record. A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

If appropriate, compliance with MPEP § 1208(A)(9) is required in listing the Denenberg reference under the heading "Prior Art of Record" appearing in the Examiner's Answer mailed August 12, 2003 (Paper No. 16).

Lastly, section 1208 of the MPEP states:

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two

appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. [Emphasis added.]

The Examiner's Answer mailed August 12, 2003 (Paper No. 16) does not comply with the above requirement in that there are no initials for MinSun Harvey, the second conferee.

Accordingly, it is


ORDERED that the application is returned to the examiner:

1. for clarification under MPEP § 1211 regarding the pertinence of the Denenberg reference listed on page 15 of the Examiner's Answer (Paper No. 16);
2. if appropriate, for compliance with MPEP § 1208(A)(9) by listing the Denenberg reference in a Supplemental Examiner's Answer under the heading "References of Record";
3. for taking corrective action regarding the appeals conference;
4. for written notification to appellant regarding the action taken; and

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5. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 
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